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Frank J. Uxa  
Stout, Uxa, Buyan & Mullins, LLP  
Suite 300  
4 Venture  
Irvine, CA 92618

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/037,567

Applicant(s)

DEAN, GREGG A.

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_

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1. The continuity data in the first line of the specification needs to be updated to reflect that the parent application (U.S. Ser. No. 09/533,319) has been issued as U.S. Pat. No. 6,383,419.

2. The following is a quotation of the appropriate paragraphs  
of 35 U.S.C. 102 that form the basis for the rejections under  
this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22 and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hörner et al. (U.S. Pat. No. 5,252,056).

Hörner discloses a set of mold sections that are configured to produce a contact lens. The set comprises a first and second contact lens mold sections (1 and 2). Hörner further discloses that a mold section can include a contour to produce a toric optical zone in the molded lens (column 6, lines 58-60).

Hörner further discloses:

"The closure means, rib-like closure elements 15 and cylindrical extension 23, which automatically maintain the closing force can also be constructed to join the two casting mould halves 1 and 2 together in quite specific orientations. For example, one rib-like closure element could project further above the circumference and a groove could be provided at a corresponding location in the inner wall 24 of the cylindrical extension 23. This ensures that the two

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casting mould halves can be joined together only in a very specific orientation relative to each other, when the higher closure element coincides with the groove." (column 6, lines 47-54).

Thus, Hörner disclose an embodiment the first and second mold section being adapted to be assembled in only a single rotational orientation, using forms (15 and 23) on the first and second mold sections. Hörner further discloses the form (15) to be a flat (see figure 1).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 23-24 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hörner in view of Kennedy (U.S. Pat. No. 5,968,422).

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Hörner discloses the apparatus as described above. Hörner does not disclose the mold section includes a contour which corresponds to a ballast portion of a contact lens, or a plurality of first and second mold sections.

Kennedy discloses a contact lens molding apparatus comprising two mold sections (see figure 2-3). One of the mold sections can comprise a contour to produce a ballast on the molded lens for the purpose of inhibiting rotation of the lens on the eye (see column 1, lines 47-53 and column 3, lines 12-17). Kennedy further suggests that multiple lens molds can be made to produce different contours to produce different toric lenses (see column 4, lines 49-53).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Hörner as such to further comprise a contour to form a ballast on the molded lens because this would allow for the molded lens to comprise a ballast inhibiting rotation of the lens on the eye as suggested by Kennedy.

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It also would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of Hörner as such to have a plurality mold sections because this would allow for a plurality of different toric lenses to be produced as suggested by Kennedy. Note

further, such a modification represents a duplication of a known part (mold sections) for a multiplied effect (producing more lense), which is generally seen as obvious to one of ordinary skill in the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (Cust. & Pat. App. 1960); St. Regis Paper Co. v. Bemis Co., Inc., 549 F.2d 833, 193 USPQ 8 (7th Cir. 1977).

7. The following reference is cited, but not relied upon, as being pertinent to the instant application:

Friske et al. (U.S. Pat. No. 5,254,000) discloses a contact lens mold comprising two mold section which can locked into only a single rotational orientation.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The


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examiner can normally be reached on Monday through Friday from  
9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are  
unsuccessful, the examiner's supervisor, Wanda Walker, can be  
reached at (703) 308-0457. The official fax phone number for  
the organization where this application or proceeding is  
assigned is (703) 872-9310 for responses to non-final action,  
and 703-872-9311 for responses to final actions. The unofficial  
fax phone number is (703) 305-3602.



Donald Heckenberg  
May 29, 2003



JAMES P. MACKEY  
PRIMARY EXAMINER  
6/2/03